UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,049	02/02/2004	John N. Gross	JNG 2004-5	1525

23694 7590 11/29/2006

J. NICHOLAS GROSS, ATTORNEY
2030 ADDISON ST.
SUITE 610
BERKELEY, CA 94704

EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/771,049	GROSS, JOHN N.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-18 and 21-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2-7,10-18 and 21-24* is/are allowed.

6)☒ Claim(s) *8,9,25-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's response of 9/8/06 has been entered. The examiner will address applicant's remarks at the end of this office action. Currently claims 2-18,21-34 are pending.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7,8,9, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 7,8,9, it is not clear as to what the portion of the claim that recites the trigger event and what it is based on is actually claiming. What structure or steps does this language define? This portion of the claims does not appear to be any kind of method step so it is not clear as to what the scope is. This portion also does not appear to be reciting any structure that is related to the system used in the method. One wishing to avoid infringement would not understand what the scope of these claims is.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 8,9,25-34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (6584450) in view of Elston (6055505).

For claims 30-32,34,Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue by interacting with a website via the Internet. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed. When a DVD is returned the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. The subscriber chooses the ordering of the titles that are to be delivered. With respect to the addition of an additional playable media item to the subscriber rental queue, Hastings discloses that the subscriber can choose preferences/attributes about what movies they would like to see and the content provider will automatically select those movies for the subscriber (a item recommendation system). See column 8, lines 43-60. This is considered to be the claimed item recommendation system because this aspect of the system of Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). The movies determined by the recommendation system are added to the queue as claimed (part g). With respect to the limitation of "interacting with the subscriber using embedded URL's" so as to *allow* the subscriber to review playable media title recommendations from the recommender system, the examiner notes that when a title is added to the queue by the recommendation system, the subscriber can use the URL for the website to review the movie by visiting the website. This ability is present in Hastings. The subscriber can go

to the website (by using the website URL) and get more information on the movie that the item recommendation system has added to the rental queue. The examiner notes that the "response field in the electronic notification" is not required in the claim because of the "and/or" language. Not disclosed is a set of notification rules that will electronically notify the subscriber when the ordering of the queue has been changed based on the monitoring of the queue and based on whether or not the queue is at or below a threshold number. Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer, the customer can be notified of the activity. An example would be the sending out of a notification when a new DVD title is being shipped to the subscriber, or when a new movie is being added to the queue based on the item recommendation system determining a new movie that satisfies the predetermined

subscriber preferences (column 8, lines 43-60). With respect to the language reciting that the notification is based on the quantity of items remaining in the queue, the examiner takes "official notice" that it is well known to notify customers of the fact that an account is getting low and that the account balance needs to be modified. An example would be a financial account where customers can be notified of a low account balance so that the customer can take steps to ensure that the balance is kept at a satisfactory level. Children going to elementary school use meal cards (pre-paid cards) to pay for meals. When the account balance is getting low the school sends out a notification to the parents to inform them that the meal card balance is getting low. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the customer with a notification when it is determined that their queue is empty and that a modification to the queue should occur if they want to receive more DVD items. The fact there are no movies in a subscriber's queue is something that the subscriber would like to know about (one of ordinary skill in the art would recognize this) so that they can modify the queue and receive another movie.

For claims 8,9,25,27,29, Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed or if an additionally playable media title should be added to the queue. When a DVD is returned (a trigger event) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because

that title is taken out of the queue and is then in a checked out status. With respect to the addition of an additionally playable media item to the subscriber rental queue, Hastings discloses that the subscriber can choose preferences/attributes about what movies they would like to see and the content provider will automatically select those movies for the subscriber (a item recommendation system). See column 8, lines 43-60. This is considered to be the claimed item recommendation system because this aspect of the system of Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). The movies determined by the recommendation system are added to the queue as claimed. Not disclosed is a set of notification rules that, based on the monitoring of the queue, will electronically notify the subscriber when the ordering of the queue has been changed or when an additionally playable media item is being added to the queue. Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer (renumbering of the ordering or the addition of a new movie from the recommender system), the customer can be notified of the activity. Examples would be the sending out of a notification when a new DVD title is being shipped to the subscriber (queue re-ordering) or when a new movie is being added (i.e. a new adventure movie with Harrison Ford was just released).

For claims 9,28, in addition to that immediately above, the prior art does not disclose that the newly added recommended playable media is designated as the next one to be delivered to the customer. Hastings discloses that one of the preferences that the subscriber can set is the order in which movies are to be received, see column 8, lines 43-65. This includes the situation where the subscriber decides that any movies recommended to them by the system of Hastings should be the next to be sent out. Because Hastings allows subscribers to have movies recommended by a recommender system and because Hastings allows a subscriber to set forth the priority for the ordering of the movies to be sent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with the ability to designate any recommended movies as the next to be delivered to the subscriber.

For claims 33, not disclosed is that the movies are by the Internet (broadband). Hastings discloses that the movies can be delivered to the customer in just about any manner and discloses in column 4, lines 22-34 that the delivery channel "may be implemented by any mechanism that provides for the transfer of items" from the

provider to the subscriber "and the invention is not limited to any particular type of delivery channel". The examiner takes "official notice" that it is old and well known in the art to deliver movies by the Internet. Movies have been distributed via the Internet for years; one of ordinary skill in the art would be very informed of this fact. Based on the teachings of Hastings and the knowledge of one of ordinary skill in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system and method of Hastings for the delivery of movies by Internet broadband because this is just another delivery channel well known to one of ordinary skill in the art.

For claim 26, in Hastings, if the subscriber wants to remove the movie that was added by the recommender system, they can do so. Hastings discloses the claimed ability to remove movies from the subscriber queue because one can use "options" on the website to remove the added movie.

5. Claims 2-7,10-18,21-24 are allowed.

6. Applicant's arguments filed 9/8/06 have been fully considered but they are not persuasive.

For claim 8, applicant has stated that Hastings does not make any hint or suggestion concerning the last limitation of the claim that deals with an item recommendation system that generates recommended playable media titles to the user. The examiner disagrees and notes that Hastings does disclose a recommendation

system. See column 8, lines 43-60. Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). The movies determined by the recommendation system are then added to the queue. Applicant has not addressed this disclosure in Hastings. The argument is found to be non-persuasive.

For claim 9, applicant has not stated why the claim is believed to be allowable. The examiner is not clear as to why applicant believes this claim is allowable. The above discussion for claim 8 also applies to claim 9 with respect to Hastings disclosing an item recommendation system. The argument for claim 9 is found non-persuasive.

For claim 25, applicant has referred to a limitation that is found in claim 21 for patentability. That limitation is not found in claim 25 so the argument is non-persuasive. As stated for claims 8 and 9, Hastings does disclose an item recommendation system that results in additional movies being added to the rental queue, and the 103 combination results in a notification being sent to the subscriber when there is activity in the rental queue, such as the addition of a new title. The newly added limitation that the recommended title is added to the rental queue does not define over the prior art.

For claim 26, when a subscriber receives a notification that informs them that a new movie has been added to the rental queue, based on the preferences that the subscriber has set forth, if they want to and in response to the notification, the subscriber can visit the website and remove the added movie. Claim 26 is just reciting the ability to remove a movie in response to the notification. The prior art satisfies what is claimed.

For claim 30, the newly added limitation concerning the use of URL's has been addressed in the rejection of record. The argument is not persuasive because this limitation is found in Hastings.

With respect to the examiner taking "official notice" of various facts, the examiner takes notice that applicant has not traversed the taking of official notice. This is taken as applicant's acquiescence regarding the facts that the examiner has taken official notice of. For applicant to properly and timely traverse the taking of official notice, a traversal had to be presented in the last response from applicant, which was not done. The taking of official notice is deemed proper.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DENNIS RUHL
PRIMARY EXAMINER